



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/028,649 | 12/20/2001 | Kelan C. Silvester | P13480 | 2723 |

8791 7590 06/21/2004

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES, CA 90025

EXAMINER

FOSTER, ROLAND G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2645

DATE MAILED: 06/21/2004

4

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,649

Applicant(s)

SILVESTER, KELAN C.

Examiner

Roland G. Foster

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 and 7-18, are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,256,354 B1 to Yoshida et al. (hereinafter "Yoshida").

With respect to claim 1, Yoshida discloses a cell phone and integrated answering machine (Fig. 1 and col. 4, lines 12-27), and a nonvolatile memory to store audio of the incoming call answered by the answering machine (col. 5, lines 29-58).

Claim 10 differs substantively from claim 1 in that claim 10 recites enabling a user of the cell phone to screen an incoming call, which reads on normal voice answering machine functions. For example, the user can screen the incoming call while it is being recorded on the integrated answering machine (col. 7, lines 52-67). In another example, the user screens incoming calls by recording them for playback at a later time using on-line (col. 8, lines 19) or off-line playback (col. 11, lines 10-29).

With respect to claim 15, see Figs. 3 and 6 where Yoshida discloses a processor (microcontroller 606), antenna 302, and a memory region 308 comprising the instructions fetched and executed by microcontroller 606 that causes the system to receive an incoming call, answer the call with a prerecorded greeting, and stored an incoming voice message (col. 6, lines 38-61 and col. 10, lines 29-45).

With respect to claim 2, see Fig. 3, speaker 314.

With respect to claim 3, the cell phone transcoder circuit decodes two channels: channel "0" at 32 kbs and channel "1" at 16 kbs (col. 6, line 62 – col. 7, line 45). Thus, a first decompression algorithm is used on a first call received on channel 0, and a second decompression algorithm is used on a second call received on channel 1. Further, during online playback mode, which requires a second incoming call to occur after the original, first incoming call was used to record the message of audio signals received and stored after a second incoming call, a second "loopback" decompression algorithm is used to play back the recorded message to a remote user via channel 1 (col. 8, lines 20-43).

With respect to claim 4, see Figs. 1 and 3.

With respect to claims 5, 13, and 18, see the on-line playback mode (col. 8, lines 1-20), which support remote retrieval of a message via the communications link (e.g., including the antenna) by calling the cell phone from a remote phone.

With respect to claims 7 and 16, the screening function (see the claim 10 rejection for further details) allows the user to listen to incoming calls while they are being recorded via a speaker. Thus, the screening function directs the compressed, digital audio signal (e.g., 32 kbps) to both the audio decompressor for decompression (conversion into analog form) so that the signal can be output through the speaker and to nonvolatile memory so that the compressed signal can be recorded as a voice message.¹

With respect to claim 8, if the user answers the incoming call, then the digital signal is decompressed (converted into analog form) for play back to the user without being stored in memory. See the claim 7 rejection for further details.

With respect to claims 9 and 17, if the answering machine records a digital message and the screening "optionally" does not takes place (col. 7, lines 53-56), then the digital signal is not being decompressed for output through the speaker. See the claim 7 rejection for further details.

With respect to claim 11, the screening function (see the claim 10 rejection for further details) is disclosed as optional (col. 7, lines 52-67). See also col. 8, lines 44-55.

With respect to claim 12, channel 0 and 1 each have a receive channel that are processed by the telephone (col. 7, lines 1-23) and, during on-line voice recording mode, "any" incoming

Art Unit: 2645

voice signal is stored (col. 7, lines 24-45). Thus, the system is enabled to record an audio signal of a second incoming call while a first call is being received.

With respect to claim 14, see the claim 5 rejection for additional details. The remotely retrieved messages are downloaded from the cell phones (e.g., phone 104) into a computer-based system (e.g., cell station 102 and existing network 114) during the retrieval process.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 1 above.

Yoshida fails to disclose that the authentication is required before the user retrieves the audio signal.

¹ Digital audio files are compressed files because they are a product of the digital sampling process, which compresses a continuous analog signal having a wide frequency spectrum (bandwidth) into discrete digital signals whose spectrum is compressed in dependence on the sampling rate.

However, "Official Notice" is taken that both the concept and advantages of voice messaging systems that require user authentication before message retrieval would have been well known in the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add user authentication before message retrieval to the voice messaging system disclosed by Yoshida.

The suggestion/motivation for doing so would have been to increase security, privacy, and user-friendliness by requiring the user to enter authentication information such as a password or PIN. For example, authentication ensures that confidential or private messages are not be played back to an inappropriate person, such as is notoriously well known in the art of voice messaging systems, especially those supporting multiple voice mail boxes (i.e., plural users) on a single device.

Art Unit: 2645

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster
Primary Patent Examiner
June 14, 2004